

## **DETAILED ACTION**

### ***Election/Restrictions***

1. In response to Applicant's arguments about the original restriction dated 5/29/2007, Applicant argued "because each of the claims of the alleged groups recited related subject matter, the alleged groups of claims are not unrelated in a manner such as provided in the examples in the MPEP". Examiner asserts that the Applicant's mere allegation that the groups recite related subject matter is based on an erroneous interpretation of the claimed subject matter by the Applicant. As sets forth in the restriction requirement dated 5/29/2007, each of the unrelated groups were separated into divergent classification. As such, the restricted inventions are independent or distinct by virtue of having acquired a separate status in the art in view of their different classifications and there would be a serious search and examination burden if restriction were not required. Further, Claims relating to the design of a hammer, claims related to the design of a nail, and claims related to a process of hammering a nail into a wall all appear to be related on the surface. However, it is obvious that the design of a hammer and the design of a nail have no relation. Further, the process of hammering a nail into a wall has no bearing on the design of either. Therefore, these examples, much like the groupings of the restriction requirement dated 5/29/2007, would be held as unrelated. The Applicant does not appear to have provided specific arguments, as opposed to mere allegations, as to why the groupings should have the same classification and would require the same search. The Examiner, however, has provided specific

Art Unit: 3622

examples (in the restriction requirement dated 5/29/2007) as to why the disclosed groupings have different modes of operation, different functions, or different effects as set forth in MPEP 806.04 and 808.01.

As per the Applicant's request for an identification of generic claims, claims 40, 54, 66, 78, 80, 90, 91, 169, 182, 183, 195, 207, 208, 209, 219, and 220 all appear to be generic with regards to the species identified in the restriction requirement dated 5/29/2007.

**2. Applicant's election with traverse of Group II in the reply filed on 6/30/2008 is acknowledged.** The arguments contained in the traversal are **not** found to be persuasive.

Applicant argues "Applicant respectfully notes that all of the claims pending in the application recite methods, and subcombinations are generally associated with apparatus claims rather than method claims". Examiner respectfully requests to be provided with the sections of the MPEP, or any laws or rules, which recite that subcombinations are typically not to be associated with method claims. Examiner has restricted numerous method claims as subcombinations in the past. If Applicant, in his experience, has never seen a restriction of method claims by subcombination, this does not mean "subcombinations are generally associated with apparatus claims rather than method claims". Further, this argument has no bearing on whether the claims are, in fact, restrictable. Even if a reasoning for restriction were to be primarily used for one subject matter, that does not mean it would be incorrect to use it for another.

Applicant further argues "the Examiner's acknowledgement that the claim groups are classified in the same class and subclass is evidence that the alleged groups are not recognized divergent subject matter" and "classification in the same class and subclass is evidence that the two alleged groups of claims would require the same field of search". To give Applicant a better understanding of 705/14, Examiner would like to provide the following two publication numbers for review: 2003/0078837 to Lo and 2002/0062253 to Dosh, both classified in 705/14. Lo is directed towards analyzing a picture and providing an appropriate advertisement. Dosh is directed towards a loyalty point program implemented across numerous merchants and consumers. According to Applicant's reasoning, these two publications, if combined into one application, would not require restriction because of they are classified similarly, and because of this classification, represent "non-divergent subject matter" and "the same field of search". However, these two publications represent the perfect example of how this couldn't be further from the truth.

Thus, the requirement is still deemed proper and is therefore made **FINAL**.

1. Claims 40-53, 90-95, 169-182, and 219-224 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Claims 54-89 and 183-218 are currently pending.

***Double Patenting***

2. Applicant is advised that should claims 54-89 be found allowable, claims 183-218 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. **Claims 54-77 and 183-206 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

**Regarding claims 54-89 and 183-218**, based on Supreme Court precedent, a method/process claim must **(1)** be tied to another statutory class of invention (such as a particular apparatus) (see at least *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) or **(2)** transform underlying subject matter (such as an article or materials) to a different state or thing (see at least *Gottschalk v. Benson*, 409 U.S. 63, 71 (1972)). A method or process claim that fails to meet one of the above requirements is not in compliance with the statutory requirements of 35 U.S.C. 101 for patent eligible subject matter. Here the claims fails to meet the above requirements because the steps are

Art Unit: 3622

neither tied to another statutory class of invention (such as a particular apparatus) nor physically transform underlying subject matter (such as an article or materials) to a different state or thing.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. **Claims 80-89 and 209-218 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

**Regarding claims 80 and 209**, this claim recites the limitation “a second functionally unrelated product”. This limitation is not clearly defined. What criteria needs to be satisfied for one product to qualify as “functionally unrelated” to another? A dress and makeup both appear to be “functionally unrelated”, however both items function to alter the appearance of a wearer, and therefore would indeed qualify as functionally related. The specification does not appear to define criteria to be met to qualify as “functionally unrelated”, and therefore one having ordinary skill in the art would not be reasonably apprised of the scope of the invention. Claims 81-89 and 210-218 inherit this rejection through dependency to claims 80 and 209.

**Regarding claims 80 and 209**, this claim recites the limitation “intended to be substantially similar”. It is unclear as to what is being limited by this claim language. Is the aesthetic property “substantially similar” or not? If it is merely intended to be

Art Unit: 3622

"substantially similar", but it turns out that it isn't, then does this scenario meet the claim language? Claims 81-89 and 210-218 inherit this rejection through dependency to claims 80 and 209.

**Regarding claims 80, 85, 209, and 214**, these claims recite the limitation "substantially similar". The term "substantially similar" is a relative term which renders the claim indefinite. It is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. Claims 81-89 and 210-218 inherit this rejection through dependency to claims 80 and 209.

**Regarding claims 80 and 209**, this claim recites the limitation "when viewed by an ordinary consumer". This limitation is not clearly defined. What criteria needs to be satisfied for a consumer to qualify as "ordinary"? On that note, how could a consumer be defined as extraordinary? The specification does not appear to define criteria to be met to qualify as "functionally unrelated", and therefore one having ordinary skill in the art would not be reasonably apprised of the scope of the invention. Claims 81-89 and 210-218 inherit this rejection through dependency to claims 80 and 209.

**Regarding claims 89 and 218**, this claim recites the limitation "informal oral agreement". What constitutes a formal oral agreement and what constitutes an informal one? What are the differences? The specification does not appear to define criteria to be met to qualify an oral agreement as "informal", and therefore one having ordinary skill in the art would not be reasonably apprised of the scope of the invention.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. **Claim 54, 59-66, 71-79, 183, 188-195, and 200-208 are rejected under 35 U.S.C. 102(b) as being anticipated by Sears (“Wrap up a Beautiful Christmas at Sears”, Sears 1982 Christmas Book, 1982).** Sears teaches the method of establishing a marketing link between 2 products that includes all of the limitations recited in the above claims.

**Regarding claims 54, 59, 78, 183, 188, and 207**, Sears teaches a catalog (which is an example of a printed ad, a sign, a mailing, a flyer, and a promotional display) having numerous examples of making available cosmetic products having a graphic depicted thereon (the graphic depicting a girl wearing clothing, the image of the clothing representing facsimile of fabric) ((3rd page, column entitled "Young Girls", items 6, 7, and 9-11) and (4th page, column entitled "Feminine favorites", items 8-11) and (5<sup>th</sup> page, column entitled "For the Strawberry Shortcake fan at your house", item 23)), making available non-cosmetic products that resemble the graphic on the cosmetic product ((3rd page, column entitled "Young Girls", items 7 and 8) and (4th page, column entitled "Feminine favorites", items 1-7) and (5<sup>th</sup> page, column entitled "For the Strawberry Shortcake fan at your house", items 12-22)), and establishing a marketing link between the cosmetic and non-cosmetic products (the 3rd, 4th, and 5th pages,

Art Unit: 3622

which depict all of the products on the same page marketed together, represent a marketing link between the products).

**Regarding claim 60, 72, 189, and 201**, Sears teaches ordering in person (this represents a brick and mortar store) or over the phone (this represents an electronic network based store) (Page 6, Right column).

**Regarding claims 61, 73, 190, and 202**, both the cosmetic and non-cosmetic products are sold via Sears.

**Regarding claims 62-64, 74-76, 191-193, and 203-204**, all examples from the Sears reference teach marketing the products under either the Tinkerbell trademark or the Strawberry Shortcake trademark, and all examples are also marketed under the Sears trademark.

**Regarding claims 65 and 194**, Sears teaches the cosmetic products as having an internal region containing a cosmetic composition ((3rd page, column entitled "Young Girls", items 6, 7, and 9-11) and (4th page, column entitled "Feminine favorites", items 9-11)).

**Regarding claims 66, 71, 79, 195, 200, and 208**, Sears teaches a catalog (which is an example of a printed ad, a sign, a mailing, a flyer, and a promotional display) having numerous examples of making available non-cosmetic products having a graphic depicted thereon (the graphic depicting a girl wearing clothing, the image of the clothing representing facsimile of fabric) ((3rd page, column entitled "Young Girls", items 7 and 8) and (4th page, column entitled "Feminine favorites", items 1-7) and (5<sup>th</sup> page, column entitled "For the Strawberry Shortcake fan at your house", items 12-22)),



Art Unit: 3622

making available cosmetic products that resemble the graphic on the non-cosmetic product ((3rd page, column entitled "Young Girls", items 6, 7, and 9-11) and (4th page, column entitled "Feminine favorites", items 8-11) and (5<sup>th</sup> page, column entitled "For the Strawberry Shortcake fan at your house", item 23)), and establishing a marketing link between the cosmetic and non-cosmetic products (the 3rd, 4th, and 5th pages, which depict all of the products on the same page marketed together, represent a marketing link between the products).

**Regarding claims 77 and 206**, Sears teaches Strawberry Shortcake watches (4th page, column entitled "Feminine favorites", items 4-7) and Strawberry Shortcake jewelry (5th page, column entitled "For the Strawberry Shortcake fan at your house", items 18-20). These represent articles of clothing.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 55-58, 67-70, 80-89, 184-187, 196-199, and 209-218 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sears ("Wrap up a Beautiful Christmas at Sears", Sears 1982 Christmas Book, 1982) in view of Williams (U.S. Publication No. 2002/0147639).**

Art Unit: 3622

**Regarding claims 55, 56, 58, 67, 68, 70, 184, 185, 187, 196, 197, and 199,**

Sears does not appear to specify conveying information at a point of sale. Williams teaches offering a coupon discount for a complementary product at a point of sale (Paragraphs 0076-0078). It would have been obvious to one having ordinary skill in the art at the time the invention was made to recommend a complementary product to a user at a point of sale since the user might make a last minute decision to purchase the other item.

**Regarding claims 57, 69, 186, and 198,** “free of charge” is simply a discount of 100%. Williams teaches that if a coupon is not accepted, to raise the amount of discount (Paragraphs 0078-0079). While Williams does not appear to specify raising the discount to 100%, it would have been obvious to one having ordinary skill in the art at the time the invention was made to give one product away at a 100% discount in the interest of promoting and making a sale on another product.

**Regarding claims 80-83, 85, 87, 209-212, 214, and 216,** Sears teaches a catalog having numerous examples of making available functionally unrelated products having a similar graphics depicted on each product within a group of products ((3rd page, column entitled "Young Girls", items 6-11) and (4th page, column entitled “Feminine favorites”, items 1-11) and (5<sup>th</sup> page, column entitled “For the Strawberry Shortcake fan at your house”, items 12-23)). Sears further teaches conveying information about the multiple groups of products including that the groups of products convey a similar design (3rd, 4th and 5th pages). This information is conveyed to

Art Unit: 3622

anyone who is sent the Sears catalog, including those individuals who already own merchandise from the catalog.

However, it could be argued that Sears does not appear to specify a customer ordering a product (which would then be distributed) and then conveying information about related products to the consumer. Williams teaches the redeeming of a coupon (which would result in the distribution of the product being discounted) and thereafter providing a discount coupon for related products (Paragraphs 0076-0078). It would have been obvious to one having ordinary skill in the art at the time the invention was made to offer a discount for related products of a previously purchased product. This would increase the likelihood of a sale being made on the related products.

**Regarding claims 84 and 213**, Sears teaches disclosing where the recipient might purchase any of the displayed products (6th page).

**Regarding claims 86 and 215**, Sears teaches products with 2 brand names, specifically "Rub-a-Dub-Dub" and "Oh, so Pretty Face Boutique" (4th page, column entitled "Young Girls", items 10 and 11).

**Regarding claims 88 and 217**, Sears teaches products as being made available by mail-order (6th page), which is a written document filled out by a consumer agreeing to pay for items selected from the catalog. This constitutes a written agreement.

**Regarding claims 89 and 218**, Sears teaches products as being made available by phone-order (6th page), which represents an oral order placed by a consumer agreeing to pay for items selected from the catalog. This constitutes an oral agreement.

***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The following references are cited to further show the state of the art with respect to matching of related products:

Sales Catalog, JCPenney, Christmas 1976.

Boyd, Malia. "Cosmetics plus". Incentive. Vol 169, No 2, Feb 1995.

U.S. Patent No. 7,194,428 to Wan

U.S. Pub No. 2001/0049645 to Tsukamoto

U.S. Patent No. 5,642,485 to Deaton

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL BEKERMANN whose telephone number is (571)272-3256. The examiner can normally be reached on Monday - Friday, 7:30 - 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric W. Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3622

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/Michael Bekerman/  
Examiner, Art Unit 3622